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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/607,481 | 06/30/2000 | Paul Warren Poole | 24850A | 2284 |
| 22889 | 7590 | 02/04/2004 | EXAMINER | |
| OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023 | | | MIGGINS, MICHAEL C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1772 | |

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,481

Applicant(s)

POOLE ET AL.

cb17

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/03.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

REJECTIONS and OBJECTIONS WITHDRAWN

1. The 35 USC 112 rejection of claim 1 set forth in paper #15, pages 2-3, paragraphs 2-4 has been withdrawn. The objection to the specification set forth in paper #15, page 3, paragraph 5 has been withdrawn.

REJECTIONS REPEATED

2. All of the 35 USC 103(a) rejections are repeated for the reasons previously of record in paper #6, pages 2-7, paragraphs 4-8.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynn et al. (U.S. Patent No. 6,093,481) in view of Nelson (U.S. Patent No. 4,985,106).

Claim 19 recites an intended use (the limitation "adapted for matching with an adjacent structure for which enhanced protection from heat or sound

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transmission is desired) and has been given little too no patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987).

The combined teachings of Lynn et al. and Nelson disclose applicant's invention substantially as claimed. However, neither reference specifically teaches wherein the insulation insert is a first insulation insert, and further including a second insulation insert encapsulated by said first facing material layer and said fibrous polymer based blanket layer adjacent to the first insulation insert and wherein the insulation insert includes at least one recessed portion.

With regard to instant claim 18, the limitation "wherein the insulation insert is a first insulation insert, and further including a second insulation insert encapsulated by said first facing material layer and said fibrous polymer based blanket layer adjacent to the first insulation insert" is a duplication of parts and it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a second insert encapsulated by the blanket layers in the insulator of Nelson in order to provide improved noise, vibration and heat insulation in a single insulation pad especially since Nelson teach the addition of another insulation pad although the pad is adhered to the outside of the insulator (see Fig. 4, column 9, lines 18-32) (applies to instant claims 18) since it has been held that mere duplication of the essential working

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parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ.

With regard to claim 19, Nelson teach an insulation insert (48 from Fig. 3) which is essentially flat and claim 19 requires at least one recess in the insulation insert. However, Nelson teaches that the vibration barrier pad (insulation insert) can be of a pre-selected size and contour (column 10, lines 47-58) and it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided at least one recess in the insulation insert in order to provide improved noise, vibration and heat insulation in a single insulation pad, since it has been held that a change in shape involves only routine skill in the art (applies to instant claim 19). *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments filed 11/17/03 have been carefully considered but are deemed unpersuasive. Applicant's summary of the teachings of Lynn et al. and Nelson provided in paper #16, pages 7-9 is acknowledged. Applicant has argued that the combination of Lynn et al. and Nelson et al. is improper.

Applicant has argued that nothing in the expressly teaches applying a fibrous polymer based blanket layer and insert to the laminated rigid foam core with a particular type of trilaminate facing that is the focus of Lynn and the examiner nevertheless posits it would be obvious to do so by dispensing with the need for objective evidence on this point. However, objective evidence for

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providing an insulation insert, layer, or pad into a foam blanket layer can be found in applicant's own IDS of 12/11/01, paper #5. The Anderson (WO 97/17508) reference teaches a panel with surface layers (3 and 4 from Fig. 1 and page 4, lines 14-31, page 5, lines 15-34) containing two foam composite blanket layers (1 and 2 from Fig. 1 and page 5, lines 15-34) encapsulated by said surface layers and a cork layer insert located between the two foam composite material layers (5 from Fig. 1 and page 5, lines 15-34), although the cork layer is not encapsulated by the foam layers. This panel is said to provide good sound insulation and good heat insulation (page 1, lines 18-25). The Anderson reference thus shows that it was known in the art to at least sandwich an insulating insert layer between two foam blanket layers and therefore, applicant's assertion that the examiner has made the combination of Lynn and Nelson without any objective evidence is not persuasive.

Applicant's argument in paper #16, pages 9-10 and 12, that the Lynn patent which was issued seven years after the Nelson patent issued did not make any mention of providing any form of insulation insert despite the availability of the Nelson patent to skilled artisans is not persuasive since as discussed above the Anderson patent (discussed in the instant office action only to rebut applicant's arguments) shows that it was known in the art to at least sandwich an insulating insert layer between two foam blanket layers thus suggesting that the combination of Lynn and Nelson is not improper.

Applicant's argument, paper #16, pages 10-11, that the proposed modification would thus require a complete redesign of the Nelson insulator is not

persuasive because it is not seen how a complete redesign of the Nelson insulator is needed when Anderson clearly shows that it was known in the art to at least sandwich an insulating insert layer between two foam blanket layers. Furthermore, the combination of Lynn and Nelson would not render the Nelson insulator unsatisfactory for its intended purpose because Anderson clearly shows that it was known in the art to at least sandwich an insulating insert layer between two foam blanket layers and because both the Lynn and Nelson inventions are drawn to insulation panels.

Applicant's statements in paper #16, pages 11-12, that the examiner further fails to explain in a convincing fashion why a skilled artisan would want to use the insert of the Nelson patent in the Lynn patent when the enhancement allegedly desired is already achieved by the novel three-ply facer used, and this would not be desirable at all and would simply detract from the more efficient approach proposed is speculative especially since Anderson clearly shows that it was known in the art to at least sandwich an insulating insert layer between two foam blanket layers to provide good sound insulation and good heat insulation (Anderson, page 1, lines 18-25).

In paper #16, pages 13-14, applicant argues that each of the dependent claims is allowable because of the alleged deficiencies in the Lynn and Nelson combination. However, the alleged deficiencies have been addressed above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (571) 272-1494. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCM *HCP*
January 30, 2004

[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

2/2/04